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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91211208
Party	Plaintiff United Industries Corporation
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNITED INDUSTRIES CORPORATION,	)	
	)	Opposition No. 91211208
Opposer,	)	
	)	TM: CITREPEL
v.	)	
	)	Serial No. 85805232
CHEMIAN TECHNOLOGY LIMITED,	)	
	)	
Applicant.	)	

**OPPOSER’S MOTION TO STRIKE APPLICANT’S SECOND  
AND FOURTH AFFIRMATIVE DEFENSES AND BRIEF IN SUPPORT**

Pursuant to Federal Rule of Civil Procedure 12(f), Opposer United Industries Corporation (“Opposer” or “UIC”) respectfully moves the Trademark Trial and Appeal Board (“Board”) to strike the mere descriptiveness (Second Defense) and failure to state a claim (Fourth Defense) affirmative defenses asserted in Applicant Chemian Technology Limited’s (“Applicant” or “Chemian Technology”) Answer in the above-referenced proceeding. (Dkt. No. 4.)

Additionally, because the Board’s determination of UIC’s motion to strike will affect the scope of discovery in this proceeding, UIC respectfully requests that the proceeding be suspended pending consideration of this motion and that all discovery and trial deadlines be reset upon disposition of this motion.

**I. PROCEDURAL BACKGROUND**

On December 18, 2012, Chemian Technology filed an application to register the mark CITREPEL in connection with “insect repellent preparations” in Class 5 (Serial No. 85805232). The CITREPEL trademark application was published for opposition in the *Official Gazette* on May 21, 2013.

After publication, UIC timely obtained an extension of time to oppose the application, and thereafter timely filed its Notice of Opposition on June 20, 2013. (Dkt. No. 1.) In its Notice of Opposition, UIC asserted trademark rights in the REPEL trademark and ownership of Registration No. 1285753 of the REPEL mark (the “REPEL Registration”). (See Dkt. No. 1 at ¶¶ 2-6.) As asserted in the Notice of Opposition and confirmed by USPTO records, UIC’s REPEL Registration was issued on July 17, 1984, and the REPEL Registration therefore has been registered on the Principal Register for more than five years. (See *id.* at ¶¶ 4-5.)

On July 30, 2013, Chemian Technology filed its Answer to UIC’s Notice of Opposition, asserting several affirmative defenses, including those of mere descriptiveness (Second Defense) and failure to state a claim (Fourth Defense). (See Dkt. No. 4.)

## **II. ARGUMENT AND CITATION OF AUTHORITY**

The Board has authority, on motion or its own initiative, to strike from any pleading a defense that is insufficient. Fed. R. Civ. P. 12(f); *see also* T.B.M.P. § 506.01. For the reasons discussed below, Chemian Technology’s Second Defense and Fourth Defense are legally insufficient and improper. UIC therefore respectfully requests that the Board strike these defenses in their entirety, in order to avoid the expenditure of unnecessary time and resources, both by the parties and the Board, on irrelevant discovery, testimony, and briefing.

### **A. Chemian Technology’s Second Defense is Improperly Pled and Legally Barred.**

It is well-established that any allegation that a mark is “merely descriptive” must be asserted as a counterclaim for cancellation, rather than as an affirmative defense, because such an allegation constitutes a collateral attack on the validity of the pleaded trademark registration. *Watchworks, Inc. v. Total Time, Inc.*, Opp. No. 121314, 2002 WL 31246834, at \*1 n.1 (T.T.A.B. Oct. 4, 2002) (“[A]pplicant has alleged mere descriptiveness as an affirmative defense. . . .

Inasmuch as such allegation constitutes a collateral attack on the validity of opposer's pleaded registration, it is required to be raised by way of a counterclaim."); *see also* 37 C.F.R. § 2.106(a) ("A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed."); *Traditional Medicinals, Inc. v. Heartland Brewery, Inc.*, Opp. No. 91159010, 2005 WL 2451675, at \*1 n.3 (T.T.A.B. Sept. 20, 2005) (applicant's putative "affirmative defense" of descriptiveness given no consideration; found to be "an impermissible collateral attack on opposer's pleaded registrations"). Consequently, because Chemian Technology failed to assert its mere descriptiveness "defense" as a counterclaim, the Board should give this "defense" no consideration.

Moreover, even if Chemian Technology had properly pled the alleged descriptiveness of the REPEL mark as a counterclaim, that counterclaim would also fail on the merits as a matter of law. "[T]here exists no dispute that a registration that is over five years old may be cancelled solely on the grounds set forth in Section 14(c)" of the Lanham Act, and mere descriptiveness is not one of those permitted grounds. *W. Worldwide Enters. Grp. Inc. v. Qinqdao Brewery*, 17 U.S.P.Q.2d 1137, 1139 (T.T.A.B. 1990) (granting motion to strike descriptiveness challenge to registration); *see also Chicago Mercantile Exch., Inc. v. Globix Corp.*, Opp. No. 91122818, 2004 WL 838408, at \*2 n.4 (T.T.A.B. Oct. 9, 2003) ("[T]he Board notes that applicant alleged mere descriptiveness as an affirmative defense. . . . In the present case, we note that opposer's Registration No. 1,576,888 is over five years old and, thus, mere descriptiveness is not available as a ground for cancellation."); *Watchworks*, 2002 WL 31246834, at \*1 n.1 ("In the present case, . . . the registration is over five years old and, thus, mere descriptiveness is not available as a ground for cancellation.").

Here, it is indisputable that UIC's REPEL Registration was issued on July 17, 1984, nearly thirty (30) years before Chemian Technology's allegation of mere descriptiveness. (*See* Dkt. No. 1 at ¶¶ 4-5.) Consequently, because Chemian Technology's Second Defense is improper both procedurally and substantively, the Board should strike this defense in its entirety. *See, e.g., Times Mirror Magazines, Inc. v. Ski W. Magazine, Inc.*, Can. No. 18736, 1992 WL 12602666, at \*1 (T.T.A.B. Sept. 10, 1992) ("Respondent did not, however, counterclaim for cancellation of petitioner's pleaded registration on the ground of mere descriptiveness, nor could it have succeeded with such a claim, because petitioner's registration issued in 1975 and descriptiveness is not an enumerated ground for cancellation of a registration which is more than five years old.").

**B. Chemian Technology's Fourth Defense Does Not Constitute a Legitimate Affirmative Defense.**

In its Answer, Chemian Technology also asserts as an affirmative defense that UIC's "Notice of Opposition fails to state a claim upon which relief can be granted," without any further explanation or elaboration. (Dkt. No. 4 at ¶ 30.)

The Board explicitly has stated that the "asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim." *John W. Carson Found. v. Toilets.com Inc.*, 94 U.S.P.Q.2d 1942, 1949 (T.T.A.B. 2010); *see also Blackhorse v. Pro Football Inc.*, 98 U.S.P.Q.2d 1633, 1637 (T.T.A.B. 2011) (striking "failure to state a claim" affirmative defense). The Board should therefore strike Chemian Technology's Fourth Defense as improper.<sup>1</sup>

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<sup>1</sup> Additionally, because Chemian Technology did not properly assert its "failure to state a claim" argument by filing a motion to dismiss UIC's Notice of Opposition, this argument has been waived. *See, e.g., Motion Picture Ass'n of Am. Inc. v. Respect Sportswear Inc.*, 83 U.S.P.Q.2d 1555, 1557 n.5

### III. CONCLUSION

For the foregoing reasons, UIC respectfully requests that Chemian Technology's Second Defense and Fourth Defense be stricken in their entireties, that this proceeding be suspended pending consideration of this motion, and that all discovery and trial deadlines be reset upon disposition of this motion.

This 21st day of August, 2013.

Respectfully submitted,



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("Inasmuch as applicant did not file a motion to dismiss the instant opposition on the basis of Fed. R. Civ. P. 12(b)(6), we treat this 'defense' as having been waived.").

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Opposer,	)	
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v.	)	
	)	Serial No. 85805232
CHEMIAN TECHNOLOGY LIMITED,	)	
	)	
Applicant.	)	

**CERTIFICATE OF SERVICE**

This is to certify that a true and correct copy of the foregoing **Opposer's Motion to Strike Applicant's Second and Fourth Affirmative Defenses and Brief in Support** was served on Applicant's Attorney of Record and Correspondence Contact on August 21, 2013 via first-class mail, with a courtesy copy by email, addressed to:

William Hare, Esq.  
McNeely, Hare and War LLP  
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Sabina A. Vayner  
*Attorney for Opposer*

**CERTIFICATE OF TRANSMITTAL**

This is to certify that a true and correct copy of the foregoing **Opposer's Motion to Strike Applicant's Second and Fourth Affirmative Defenses and Brief in Support** is being filed electronically with the TTAB via ESTTA on this day, August 21, 2013.



Sabina A. Vayner  
*Attorney for Opposer*